

REMARKS

Overview

The Examiner responded in the prior Office Action as follows: rejected claims 16, 21, 24, 28, 85-86 and 88-93 under 35 U.S.C. § 102(e) as being anticipated by Hazzard et al. (U.S. Patent Application No. 2005/0125389); and rejected claim 87 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants hereby amend claim 87, and traverse the rejections of the claims as discussed below. Thus, claims 16, 21, 24, 28, and 85-93 are pending, and claims 17-20, 22-23, 25-27 and 29-84 are currently withdrawn.

Applicants also thank Examiner Shah for her consideration during the telephone interview with Applicants' representative on November 1, 2007 on this application. During the interview, the procedures for demonstrating diligence as part of a Rule 131 Declaration were discussed, as discussed further below.

Analysis

The Examiner has rejected claim 87 under 35 U.S.C. § 101 as being directed to non-statutory subject matter due to the recitation of a transmitted data signal. However, since the issuance of the prior Office Action, the Federal Circuit has reiterated its prior position that claims in the form of claim 87 as amended are statutory subject matter. In particular, in the *In re Nuijten* case, opinion number 2006-1371, issued September 20, 2007, the Federal Circuit ruled that a claim that recited "A signal with embedded supplemental data . . ." was not statutory subject matter. However, a related claim in the same application that recited a "storage medium having stored thereon a signal with embedded supplemental data . . ." was found to be allowable subject matter. Claim 87 as amended similarly recites "wherein the computer-readable medium stores a generated data signal . . .", and thus is statutory subject matter for the same reasons as indicated in the *In re Nuijten* case. Accordingly, Applicants request that the Examiner withdraw this rejection.

The Examiner has rejected each of the other previously pending claims 16, 21, 24, 28, 85-86 and 88-93 under 35 U.S.C. § 102(e) as being unpatentable over Hazzard. However, each

of the pending claims as rejected includes features and provides functionality not disclosed by Hazzard, as discussed below, and thus is allowable over that reference.

Furthermore, the subject matter of Applicants' pending claims was invented before the priority date of the Hazzard reference, and thus the Hazzard reference does not qualify as prior art for those claims under 35 U.S.C. § 102(c). In particular, in the response filed May 31, 2007 to the earlier Office Action dated December 6, 2006, Applicants filed two Declarations Of Prior Invention under 37 CFR 1.131 to demonstrate that Applicants conceived of the invention prior to the December 9, 2003 filing date of the Hazzard patent application, and diligently pursued the invention from a time prior to December 9, 2003 until the filing of the present application on January 27, 2004.

In the current Office Action dated August 8, 2007, the Examiner has agreed that the previously filed Declarations establish conception of the invention prior to the December 9, 2003 filing date of the Hazzard patent application, but asserts that the previously filed Declarations did not sufficiently establish diligence during the relevant time period due to not reciting dates of acts relied on to establish diligence. However, Applicants disagree that the previously filed Declarations did not sufficiently establish diligence, and request that the Examiner withdraw that assertion and the rejections based on the Hazzard reference. In particular, the previously filed Declaration of James White established that acts establishing diligence occurred before the relevant period began on December 9, 2003, and during each full week in the period prior to December 9, 2003 until the filing of the present application on January 27, 2004, those being the weeks beginning with the following dates: December 14, 2003; December 21, 2003; December 28, 2003; January 4, 2004; January 11, 2004; January 18, 2004; and January 25, 2004. Accordingly, Applicants believe that the previously filed Declarations established sufficient dates regarding acts that establish diligence during the period from a time prior to December 9, 2003 until the filing of the present application on January 27, 2004, and thus Hazzard is rendered ineffective as prior art. Accordingly, the rejection of claims 16, 21, 24, 28, 85-86 and 88-93 is moot, and the pending claims are believed to be in allowable form.

Moreover, Applicants have further concurrently filed a revised Declaration Of Prior Invention under 37 CFR 1.131 by James White, which further provides numerous particular dates of acts related to diligence that occurred from December 9, 2003 until the filing of the present application on January 27, 2004, as well as at least one particular date prior to December

9, 2003 on which acts related to diligence occurred. Thus, based on this revised Declaration as well, Applicants have additionally demonstrated that they diligently pursued the invention from a time prior to December 9, 2003 until the filing of the present application on January 27, 2004.

During the telephone interview between Examiner Shah and Applicants' representative on November 1, 2007, the conversation included a discussion of (1) what types of periods between activities are typically found to support a finding of diligence; and (2) whether the relevant period during which diligence is to be shown begins on the day prior to a third-party's entrance as possible prior art (in our case, on December 8, 2003, which is the day prior to Hazzard's application filing date of December 9, 2003), or whether Applicants need to establish earlier dates of activity prior to the third-party's entrance such that diligence must be shown from those earlier dates until the third-party's entrance and then continuing on until Applicants' reduction to practice on January 27, 2004.

With respect to subject (1) regarding what types of periods between activities are typically found to support a finding of diligence, the Examiner noted during the recent telephone interview that the MPEP mentions a particular case in which diligence was not established due to a two-day period of inactivity. However, as Applicants' representative explained during the telephone interview, that case found a lack of diligence not due to a two-day period being too short, but based on the inventors having asserted no diligence activity of any kind for the entire relevant period. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983). The more typical caselaw on diligence includes periods of inactivity of much larger than 2 days that are found to establish diligence. For example, the CCPA explicitly found that a 2-day delay between executing documents and mailing them satisfied diligence, as well as other periods without activity in that case, stating that "[a]s to the other alleged lapses of activity urged by appellant, these are all of such short duration that we consider them to fall within the limits of reasonable diligence, referred to in the cases cited by the board, which recognize the inevitable minor interruptions accompanying the conduct of patent prosecution." *Application of Fancher*, Patent Appeal No. 8152, 410 F.2d 813 (CCPA 1969). As part of that same case, for example, the CCPA found that a 10 day period for review of the application by the inventors was sufficient diligence.

More generally, periods of time such as 4 months and 6 months during which attorneys prepared patent application have been found to satisfy diligence, including when the attorneys were also working on other projects and spent significant periods of time between diligence-related

activities. For example, in *Gould v. General Photonics Corp.*, 534 F.Supp. 339 (N.D. California 1982), the court concluded that “[f]rom December 2, 1958 to April 6, 1959 [a period of over 4 months], Mr. Keegan diligently applied himself to the preparation and filing of Gordon Gould’s original applications (filed on April 6, 1959),” although the court did not list particular dates on which diligence-related activity occurred. In a 1994 decision by the Board of Patent Appeals and Interferences (*English v. Ausnit*, Interference No. 102,361, 38 USPQ2d 1625, 1994), however, the Board did recite attorney actions (listed below) that occurred over a 6-month period in which the attorney prepared and filed a patent application, and the Board concluded that “this evidence establishes attorney diligence for the period beginning 20 June 1986 and ending with Ausnit’s 22 December 1986 filing date.”

June 20, 1986 – inventor sent letter requesting that attorney prepare patent application

June 25 – attorney received request to prepare patent application; read and studied attached sketches

June 26 – case was docketed and assigned to other attorneys; sketches given to drafting

Sept. 3 – drafting finished

Nov. 11 – attorney finished draft of application

Nov. 12 – typing of draft application completed

Nov. 20 – application papers mailed to inventor

<date unclear> - inventor requested modifications to draft application

Dec. 3 – revised application sent to inventor

Dec. 9 – inventor mailed signed application papers to attorney

Dec. 15 – attorney receives the signed application papers

Dec. 22 – attorney files application with the Patent Office

Thus, in that case, two periods of over 2 months each (from June 26 to September 3, and from September 3 to November 11) occurred without any indication of particular diligence-related activity, as well as numerous other shorter periods of time (e.g., 8 days between completing the preparation of the draft application and sending it to the inventor for review, 7 days between receiving executed application papers and filing the patent application, etc.), and diligence was nonetheless established.

Accordingly, Applicants submit that the much shorter periods of inactivity that occurred in this case during the relevant period from December 8, 2003 to January 27, 2004 (at most 6 business days), coupled with the activities throughout the relevant period in preparing the application, clearly demonstrate diligence during the relevant period.

During the recent telephone interview, the Applicants' representative and the Examiner also discussed subject (2), regarding whether the relevant period during which diligence is to be shown (a) begins on the day prior to a third-party's entrance as possible prior art (in our case, on December 8, 2003, which is the day prior to Hazzard's application filing date of December 9, 2003), or instead (b) based on an earlier date that Applicant must establish (such that diligence must be shown from those earlier dates until the third-party's entrance and then continuing on until Applicants' reduction to practice on January 27, 2004). It is Applicants' understanding based on that interview that the Examiner believes that interpretation (b) is the appropriate standard.

As a threshold matter, even if the Examiner is correct, Applicants believe that the currently filed Rule 131 Declaration still establishes diligence for those periods of time. In particular, Applicants have indicated that activities related to preparing the application occurred after the invention disclosure meeting on at least November 11, 2003. Accordingly, assuming that the Examiner's understanding of the relevant caselaw is correct, the Examiner should consider the delay of just over a month between November 11, 2003 and December 17, 2003. However, as discussed above, this period of just over a month is much shorter than periods of delay found in numerous cases in which diligence has been established, including the *Ausnit* case discussed above, and thus Applicants believe that diligence is therefore established even under this standard.

Moreover, Applicants believe that the caselaw demonstrates that the relevant period in which establish is that discussed in (a) above rather than (b) above, such that the relevant period to establish diligence begins on the day prior to a third-party's entrance as possible prior art (in our case, on December 8, 2003, which is the day prior to Hazzard's application filing date of December 9, 2003). Numerous cases state that a party's activities before the third-party's entrance occurs are not relevant to establishing diligence. For example, the case *Hull v. Davenport* (90 F.2d 103, CCPA 1937) considered the relevant period for which diligence must be shown, reviewing various prior cases, and concludes the following:

[t]he weight of authority, however, regards his [the first conceiver's] diligence sufficiently shown if it be found that he was diligent from a time just prior to the second conceiver's entrance into the field to the first conceiver's reduction to practice . . . His lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts . . . it follows that his adversary should only be concerned with what happened immediately prior to and after his entry into the field.

Hull v. Davenport, 104 (emphasis added).

In addition, the MPEP is in accord, stating the following (with emphasis added).

715.07(a) Diligence

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). . . . See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

2138.06 "Reasonable Diligence"

CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO PRACTICE THE INVENTION

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts").

Accordingly, Applicants believe that the caselaw is clear that the relevant period in which diligence is to be shown begins "just prior" or "immediately preceding" the December 9, 2003 filing date of Hazzard, and thus that any activity before December 8, 2003 related to diligence is not relevant for this determination. As such, it is clear that Applicants have established diligence during the relevant period of December 8, 2003 to January 27, 2004.

Furthermore, if the Examiner determines that Applicants have not established diligence, the Applicants request that the Examiner clearly indicate the basis of her decision, so as to clarify the issues for subsequent petition or appeal. In particular, if the Examiner determines that Applicants have not established diligence based on interpretation (b) discussed above, Applicants request that the Examiner clearly indicate that her decision is based on that interpretation.

Moreover, even if Hazzard were valid prior art, the pending claims are nonetheless patentable over Hazzard. In particular, each of the pending claims as rejected includes features and provides functionality not disclosed by Hazzard, and thus is allowable over that reference.

The pending claims are generally related to techniques for providing consumers with access to Web services that are available from third-party or otherwise unrelated Web service providers, such as by invoking the Web services on behalf of the consumers by interacting with computing systems of the Web services providers. As one example of features and functionality not disclosed by Hazzard, pending independent method claim 16 recites “providing to the consumer access to the registered Web service by invoking that Web service from the provider of the Web service on behalf of the consumer and by providing response information from the invoking to the consumer”. Independent computer-readable medium claim 85 and independent computing device claim 91 each recite similar language.

Conversely, Hazzard is unrelated to providing users with access to remote Web services or other invocable services by invoking such services from third-party providers on behalf of the users. Instead, Hazzard generally describes a service engine that is able to download software applications from vendors, and then allow users to interactively use those software applications. In particular, the service engine hosts (or executes) the software applications, and allows users to interactively use the hosted software applications over a network, such as via a Web browser. Hazzard contrasts the described advantage of such hosted software with problems related to situations in which users must download software applications to their own computing systems before executing the software application. In describing how users may interact with the hosted software applications, Hazzard indicates the following:

[the service engine] may provide a portal through which a user system 20 . . . may access service engine 34. The portal may comprise, for example, an interface such a graphical user interface . . . or other suitable portal for accessing service engine 34 *and*

The [user] access may be provided by executing a service application 62 for the service within a portal and allowing the user access to the service through the portal.

Hazzard, paragraphs 37 and 29.

The software applications may be “standard” applications that are mass produced for large numbers of customers, such as an Oracle suite application, and/or customized applications. Hazzard defines that the service engine provides a “service” to a user by allowing a user to

obtain such software application access, indicating that a “service comprises use of a software application” and that “[p]roviding a user access to a service [by the service engine] may refer to allowing a user to use a software application associated with the service.” (Hazzard, Abstract and paragraph 19; see also paragraph 15.)

Thus, Hazzard’s hosting of software applications for interactive use by users is unrelated to providing consumers with paid access to remote Web services by invoking such services from third-party providers on behalf of the consumers. Furthermore, Hazzard provides no teaching, suggestion or motivation to modify its hosting of software applications for interactive use by users to provide the claimed functionality related to invoking Web services from third-party providers on behalf of consumers. Accordingly, for at least this reason, independent claims 16, 85 and 91 are patentable over Hazzard.

The pending dependent claims include the features of those claims from which they depend, and are thus allowable for the same reasons as those claims. Moreover, the pending dependent claims also recite additional features lacking in the cited references, and are thus allowable on the basis of those features as well, although these additional features are not enumerated here for the sake of brevity.

Accordingly, for all of the reasons discussed above, the rejection of the pending claims based on Hazzard is traversed, and the pending claims are thus allowable over the cited prior art.

Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable, as are the withdrawn claims that depend from the independent method claim 16. Applicants therefore respectfully request the Examiner to reconsider this application and timely allow all pending claims. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 694-4815.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC

/James A. D. White/

James A. D. White
Registration No. 43,985

JDW:dd

Enclosure:
Declaration

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031